

Remarks

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This amendment is responsive to the Office Action dated June 7, 1006; a one month Extension of Time is provided herewith. Claims 1-3 are allowed; claims 4 and 5 remain for consideration.

A telephone interview was held between the undersigned and SPE Ryan on July 12, 2006. The issue is whether a narrow range is new matter under 35 USC 112, para. 1, when the disclosure included a slightly larger range of pressure. In reply, SPE Ryan related there must be express, inherent or implicit support for the claims as a whole; inherency being established if the narrower range is necessarily present in the broader range and would be so recognized by skilled artisans. Further, the original disclosure including claims, examples and ranges must be considered. Patentability under 35 USC 112, first paragraph, would be shown if present ranges are implicitly disclosed in the specification. No agreement was reached.

Enclosed is the Declaration of Michael L. Perry. It describes in detail the disclosure and claims relating to the pressure of a reactant gas being greater than the pressure of the coolant by a pressure differential which has ranges of values.

The parent (CIP) application differed from the original application, as related to pressure, by claiming 0-2 psi. The Declaration states that the claimed range of 0.2 - 1.7 psi is disclosed in the test results of Fig. 11, and is inherently and necessarily within the parent range of 0-2 psi and would be so recognized by those skilled in the art.

The presently claimed ranges are clearly enabled, by Fig. 11 and pages 15 and 16 if nothing else. The policies eluded to by SPE Ryan seem to be contrary to the controlling law in this case. Specifically, In Re Brower and Fuzek, 433 F.2d 813, 167 USPQ 684 (CCPA, 1970): claims to single chemical additives were allowed in a continuation application where the parent application emphasized use of both additives but gave an example of each single additive. The Court said, "...it is imperative to note that section 120..." requires the parent to "...disclose the invention 'in such full, clear, concise and exact terms...to make and use the same'." MPEP 2172 III permits narrowing by amendment.

In Re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA, 1976), quoted in MPEP 2163.05 III: "That what appellants claim as patentable to them is less than what they

describe as their invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."

1,2. The specification is objected to "as failing to provide proper antecedent basis for the claimed subject matter." Pages 15 and 34 have been amended so as to conform the specification to the claims. Therefore, withdrawal of the objection to the specification is hereby respectfully requested.

3. As understood, the eligibility of the present application as a continuation of 10/012,157 is challenged under 35 USC 132 for introducing new matter. The Declaration and the discussion hereinbefore illustrate quite clearly that the original application, the second application and the present application all provide support for the presently claimed range, in Fig. 11, if nowhere else. "The content of the drawings may also be considered in determining compliance with the written description requirement. *In Re Barker*, 559 F.2d (588, 194 USPQ 470 (CCPA 1977))." *In re Kaslow*, 707 F.2d 1366, 217 USPQ 1089 (Fed. Cir. 1983). If the applicants' invention described in the parent application is statutorily (-112, ¶1) as anywhere above zero psi so long as it is less than 2 psi, their invention in the parent is 0.1 psi; it is 0.2 psi; it is 0.5 psi; it is 1 psi; it is 1.5 psi; it is 1.7 psi; it is 1.8 psi; and it is all pressures in between. Paragraphs 9, 10, 14 and 15 establish testing in the original and parent application in a range of 0.2-1.7 psi, which comprises a working example of 0.2-1.7 psi. Since the support is inherent in the larger range (0 to 2 psi of the parent), and since support is found in the example described with respect to Fig. 11 on page 34 in all three applications, withdrawal of this objection is respectfully requested. This falls within the rationale of *Wurtheim* as it is quoted in MPEP 2163.05 III.

4. Claims 4 and 5 are rejected under -112, first paragraph, for lack of written description. There is no doubt, in view of the Declaration and the foregoing discussion, that those skilled in the art would understand that the inventors were possessed of 0.2 to 1.7 psi since they were possessed of all of that plus 0.2 psi more at the low end and 0.3 psi more at the high end (0-2 psi). Furthermore, the description includes the presently claimed range in Fig. 11 and the discussion of 0-4 psi on page 34 of all three applications. Therefore, reconsideration and withdrawal of this rejection is respectfully requested.

5. Claims 4 and 5 are again rejected under -112, first paragraph, for lack of enablement. The Declaration shows enablement for 0.2-1.7 psi in Fig. 11 and page 34 as well as in the description of how to adjust the pressure, on pages 15 and 16 of all three applications. If one could adjust the pressure to anything between 0 and 2 psi, one could certainly adjust the pressure to 0.2 psi, or to 1.7 psi, or to any pressure in between. Reconsideration and withdrawal of this rejection is respectfully requested.

6. This paragraph is a statement, not an objection or a rejection. However, if 0-2 is enabled, anything within that is certainly enabled; as stated hereinbefore, one skilled in the art would have no problem achieving a pressure between 0.2 and 1.7 psi if one skilled in the art could pick a pressure between 0 and 2 psi. See Declaration paragraphs 15, 16 and 21.

To save the Examiner considerable time when this case is taken up, a short phone call is recommended should any issue herein still be unresolved. A five minute phone call can save the Examiner a lot of work. A few minutes on the phone could clarify a point, or result in a supplemental response which would further limit or dispose of issues. Such a phone call would be deeply appreciated.

Respectfully submitted,



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